

Customer No.: 31561  
Application No.: 10/711,471  
Docket NO.: 13363-US-PA

### **REMARKS**

#### **Present Status of the Application**

A correction for the abstract is required. The Office Action rejected claims 1-2, 4 under 35 U.S.C. 102(b), as being anticipated by Rayburn (U.S. 3,758,833). The Office Action also rejected claims 3 and 5 under 35 U.S.C. 103(a) as being unpatentable over Rayburn. In addition, claims 6-14 has been allowed.

Applicants have amended the abstract in which "comprise" is amended to "include".

Applicants have amended claim 1 to overcome the rejection and newly added claim 15. The limitations added in claims 1, 15 are shown in Fig. 1A and Fig 2A, and no new matter is entered. After entry of the foregoing amendments, claims 1-15 remain pending in the present application.

#### **Discussion of Office Action Rejections**

*Applicants respectfully traverse the 102(b) rejection of claims 1-2, 4 because Rayburn (U.S. 3,758,833) does not teach every element recited in these claims.*

In order to properly anticipate Applicants' claimed invention under 35 U.S.C 102, each and every element of claim in issue must be found, "either expressly or inherently described, in a single prior art reference". "The identical invention must be shown in as complete details as is contained in the .... claim. Richardson v. Suzuki Motor Co., 868 F. 2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)." See M.P.E.P. 2131, 8<sup>th</sup> ed., 2001.

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The present invention is in general related a capacitor structure as claim 1 recites:

Claim 1. A capacitor structure, comprising:

a conductive layer, wherein the conductive layer has a first spiral pattern and a second spiral pattern arranged alternatively with respect to each other, *and the terminal of the first spiral pattern and the terminal of the second spiral pattern at the outside of the capacitor structure extend to different directions*; and

a dielectric layer, disposed between the first spiral pattern and the second spiral pattern.

Rayburn fails to disclose, teach or suggest the feature of that the terminal of the first spiral pattern and the terminal of the second spiral pattern at the outside of the capacitor structure extend to different directions. In Rayburn's reference, a pair of elongated lead wire members 22, 24 are placed on opposite sides of the layers of foil strips 16, 18, and the two foil strips 16, 18 have been wound from the elongated lead wire members 22, 24. The terminals of the two foil strips 16, 18 at the outside of the capacitor extend to the same direction, as shown in Figs. 3 and 4. However, in claim 1 of the present invention, the terminal of the first spiral pattern and the terminal of the second spiral pattern at the outside of the capacitor structure extend to different directions. Such that the terminals of the first and second spiral patterns at the outside of the capacitor structure can be respectively electrically connected to a corresponding voltage. If the terminals of the first and second spiral patterns extend to the same direction, they may be short to each other because the capacitor of the present invention is formed on a chip and the size of the capacitor is minimized. Thus, Rayburn does not teach every element recited in claim 1.

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For at least the foregoing reasons, Applicant respectfully submits that independent claim 1 patently define over the prior art reference, and should be allowed. For at least the same reasons, dependent claims 2-5 patently define over the prior art as well.

*Applicants respectfully traverse the rejection of claims 3, 5 under 103(a) as being unpatentable over Rayburn because a prima facie case of obviousness has not been established by the Office Action.*

To establish a prima facie case of obviousness under 35 U.S.C. 103(a), each of three requirements must be met. First, the reference or references, taken alone or combined, must teach or suggest each and every element in the claims. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skilled in the art, to combine the references in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of the three requirements must "be found in the prior art, and not be based on applicant's disclosure." See M.P.E.P. 2143, 8<sup>th</sup> ed., February 2003.

Applicants submit that, as disclosed above, Rayburn fails to teach or suggest each and every element of claim 1 from which claims 3, 5 depend. Because independent claim 1 is allowable over the prior art of record, its dependent claims 3, 5 are allowable as a matter of law, for at least the reason that these dependent claims contain all features of their respective independent claim 1.

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Applicants also add claim 15. Rayburn fails to teach or suggest the first spiral pattern and the second spiral pattern at the outside of the capacitor structure have a larger width than that at the inside of the capacitor structure.

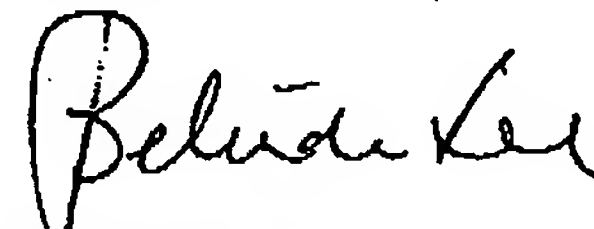
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### CONCLUSION

For at least the foregoing reasons, it is believed that the pending claims are in proper condition for allowance. If the Examiner believes that a telephone conference would expedite the examination of the above-identified patent application, the Examiner is invited to call the undersigned.

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Respectfully submitted,



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